

Docket No.: 2003P16318

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

Applic. No. : 10/577,589 Confirmation No.: 8190
Inventor : Andreas Schmidt, et al.
Filed : April 27, 2006
Title : Method for Transmitting Encrypted Useful Data Objects
TC/A.U. : 2131
Examiner : Michael R. Vaughan
Customer No. : 24131

Hon. Commissioner for Patents
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Sir:

This is an appeal from the final rejection in the Office action dated January 15, 2010, finally rejecting claims 22-46.

Appellants submit this *Brief on Appeal* including payment in the amount of \$540.00 to cover the fee for filing the *Brief on Appeal*.

Real Party in Interest:

This application is assigned to Siemens Aktiengesellschaft of München, Germany.

The assignment will be submitted for recordation upon the termination of this appeal.

Related Appeals and Interferences:

No related appeals or interference proceedings are currently pending which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims:

Claims 22-46 are rejected and are under appeal. Claims 1-21 were previously cancelled.

Status of Amendments:

No claims were amended after the final Office action. *A Notice of Appeal* was filed on April 15, 2010 together with a *Pre-Appeal Brief Request for Review*.

Summary of the Claimed Subject Matter:

The subject matter of each independent claim is described in the specification of the instant application. Examples explaining the subject matter defined in each of the independent claims, referring to the specification by page and line numbers, and to the drawings, are given below.

Independent claim 22 reads as follows:

A method of determining the usability of encrypted user data objects by a first telecommunications terminal **[Fig. 2] [pg. 8, line 18 - pg. 11, line 19]**, which comprises the following steps:

receiving, by a switching component of a telecommunications network **[VK, EMV of Figs. 1 and 2]**, an encrypted user data object **[NDO of Figs. 1, 2 and 3]** to be transmitted to the first telecommunications terminal **[TG2 of Figs. 1 and 2] [pg. 8, line 29 - pg. 9, line 3]**, and a reference **[Transcoding-URI of Fig. 3]** for checking a usability of the encrypted user data object **[NDO of Figs. 1, 2 and 3]** by the first telecommunications terminal **[pg. 8, line 29 - pg. 9, line 3]**, the switching component not having access to a content of the encrypted user data object due to the encryption **[pg. 6, lines 4 – 6]**;

the switching component **[VK, EMV of Figs. 1 and 2]** determining a profile relating to capabilities of the first telecommunications terminal to process a user data object **[2 of Fig. 2] [pg. 7, lines 26 – 28; pg. 19, lines 5 -7]**;

transmitting, by the switching component **[VK, EMV of Figs. 1 and 2]**, a request together with the determined profile of the first telecommunications terminal to a data provisioning component **[DBK of Fig. 2]** in accordance with an address **[pg. 9, lines 20-22]** contained in the reference for checking the usability of the encrypted

user data object **[NDO of Figs. 1, 2 and 3]** by the first telecommunications terminal **[TG2 of Figs. 1 and 2]** [pg. 7, line 29 – pg. 8, line 2; pg. 10, lines 10 – 24];

transmitting, from the data provisioning component **[DBK of Fig. 2]** to the switching component **[VK, EMV of Figs. 1 and 2]**, information relating to a result of the check on the usability of the encrypted user data object **[NDO of Figs. 1, 2 and 3]** to be transmitted for the first telecommunications terminal **[4 of Fig. 2]** [pg. 10, line 32 – pg. 11, line 3]; and

the switching component **[VK, EMV of Figs. 1 and 2]** processing the encrypted user data object **[NDO of Figs. 1, 2 and 3]** in accordance with the information relating to the check, and notifying the first telecommunications terminal thereof **[pg. 11, lines 11 - 19]**.

Independent claim 46 reads as follows

46. A telecommunications system **[Fig. 1; Fig. 2]** for determining the usability of encrypted user data objects by a first telecommunications terminal, comprising **[TG2 of Figs. 1 and 2]** [pg. 8, line 18 - pg. 11, line 19]:

a switching component **[VK, EMV of Figs. 1 and 2]** [pg. 16, lines 15 – 32];

a data provisioning component **[DBK of Fig. 2]** [pg. 17, lines 11 – 26]; and

at least one first telecommunications terminal **[TG2 of Figs. 1 and 2]** **[pg. 17, lines 2 – 11];**

said switching component **[VK, EMV of Figs. 1 and 2]** configured to provide an encrypted user data object **[NDO of Figs. 1, 2 and 3]** to be transmitted to the at least one first telecommunications terminal **[TG2 of Figs. 1 and 2]** and a reference for checking a usability of the encrypted user data object by the at least one first telecommunications terminal **[pg. 8, line 29 - pg. 9, line 3]**, the switching component not having access to a content of the encrypted user data object due to the encryption **[pg. 6, lines 4 – 6];**

said switching component **[VK, EMV of Figs. 1 and 2]** additionally configured to determine a profile relating to capabilities of the at least one first telecommunications terminal to process a user data object **[pg. 7, lines 26 – 28; pg. 19, lines 5 -7];**

said switching component **[VK, EMV of Figs. 1 and 2]** configured to transmit a request, together with the determined profile of the first telecommunications terminal **[TG2 of Figs. 1 and 2]**, to said data provisioning component **[DBK of Fig. 2]** in accordance with an address **[pg. 9, lines 20-22]** contained in the reference for checking whether the encrypted user data object to be transmitted is usable for

processing by the at least one first telecommunications terminal **[TG2 of Figs. 1 and 2]** [pg. 7, line 29 – pg. 8, line 2; pg. 10, lines 10 – 24];

said data provisioning component **[DBK of Fig. 2]** configured to transmit to the switching component **[VK, EMV of Figs. 1 and 2]**, information relating to a result of the check on the usability of the encrypted user data object to be transmitted for the at least one first telecommunications terminal **[4 of Fig. 2]** [pg. 10, line 32 – pg. 11, line 3]; and

said switching component **[VK, EMV of Figs. 1 and 2]** configured to process the encrypted user data object **[NDO of Figs. 1, 2 and 3]** in accordance with the information relating to the result of the check, and to notify the at least one first telecommunications terminal thereof [pg. 11, lines 11 - 19].

Grounds of Rejection to be Reviewed on Appeal

1. Whether or not claims 22-42 and 44-46 are obvious over international publication WO 02/43414 to Mostafa, in view of US Patent No. 6,963,972 to Chang et al., and further in view of US Patent No. 7,296,295 to Kellerman et al., under 35 U.S.C. § 103(a).
2. Whether or not claim 43 is obvious over international publication WO 02/43414 to Mostafa in view of US Patent No. 6,963,972 to Chang, US Patent No. 7,296,295 to Kellerman as applied to claim 22 above, and further in view of USP

application publication 2002/0077986 to Kobata et al., under 35 U.S.C. § 103(a).

Argument:

- I. **Whether or not claims 22-42 and 44-46 are obvious over PCT publication WO 02/43414 to Mostafa, in view of US Patent No. 6,963,972 to Chang et al., and further in view of US Patent No. 7,296,295 to Kellerman et al., under 35 U.S.C. § 103(a).**

On page 3 of the final Office Action, Appellants' claims 22 – 42 and 44 – 46 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over PCT Publication WO 02/43414 to Mostafa ("**MOSTAFA**"), in view of US Patent No. 6,963,972 to Chang et al. ("**CHANG**"), and further in view of US Patent No. 7,296,295 to Kellerman et al ("**KELLERMAN**")

Appellants respectfully traverse the foregoing rejections of the claims. Rather, Appellants' claims are believed to be patentable over the cited art, as follows.

- A. **None of the references cited in the Office Action teach or suggest, among other limitation of Appellants' claims, a data provisioning component transmitting information relating to the result of a usability check to a switching component, as required by Appellants' claims 22 and 46.**

Appellants' independent claim 22 recites, among other limitations:

transmitting, from the data provisioning component to the switching component, information relating to a result of the check on the usability of the encrypted user data object to be transmitted for the first telecommunications terminal;

Appellants' independent claim 46 recites a similar limitation, among others.

However, among other limitations, the cited prior art does not teach or suggest the above-quoted limitation of Appellants' claims.

More particularly, pages 3 – 4 of the final Office Action point to page 6 of the **MOSTAFA** reference, lines 21 – 23 and page 19 of the **MOSTAFA** reference, line 5, as allegedly teaching the above- limitation of Appellants' claims. Appellants respectfully disagree.

Rather, the passages of the **MOSTAFA** reference cited in the Office Action are silent about any relevant communication between the MMS server of **MOSTAFA** (analogized in the Office Action to Appellants' claimed data provisioning component) and the MMS rely A of **MOSTAFA** (analogized in the Office Action to Appellants' claimed switching component). In contrast thereto, Appellants' claims require, among other limitations, **a data provisioning component transmitting information relating to the result of a usability check to a switching component**. As such, the **MOSTAFA** reference fails to teach the above-limitation of Appellants' claims. The further references cited in the Office Action do not cure this deficiency of the **MOSTAFA** reference.

- B. Encrypting the multimedia message of MOSTAFA, as taught in CHANG, would render the modified device inoperable and unsatisfactory for its intended purpose, in contradiction to M.P.E.P. § 2143.01(V), and, thus Appellants' claims 22 and 46 are not obvious over the cited art.**

Appellants' claims 22 and 46 require that the user data object being checked for usability by the first telecommunications terminal is an encrypted user data object, the content of which is inaccessible to the switching component, due to the encryption. For example, claims 22 and 46 recite, among other limitations:

..., the switching component **not having access to a content** of the encrypted user data object due to the encryption;

Page 4 of the Office Action acknowledges that **MOSTAFA** does not disclose that the data object is encrypted, but cites the **CHANG** reference as allegedly teaching encryption of a data object, when taken in combination with **MOSTAFA**. However, the teachings of **CHANG** are not combinable with **MOSTAFA** in the manner suggested in the Office Action, because such a combination impermissibly destroys the operability of the **MOSTAFA** reference.

More particularly, M.P.E.P. § 2143.01(V) states, in part:

V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Thus, M.P.E.P. § 2143.01(V) states that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Modifying the teachings of **MOSTAFA** to include the encryption of **CHANG** would render the

device of **MOSTAFA** unsatisfactory for its intended purpose, and, in fact, completely inoperable.

More particularly, without further differentiation employing the encryption of **CHANG** on the multimedia message of **MOSTAFA** would prevent the relays of **MOSTAFA** from having access to the addressing information identifying the intended recipient of the message, which addressing information is sent as part of the media content of the message of **MOSTAFA**. See, for example, pg. 17 of **MOSTAFA**, lines 5-8 and pg. 7 of **MOSTAFA**, lines 6-7, which describe that, in **MOSTAFA**, the **addressing information for the message recipient is encapsulated within the multimedia message**. Therefore, if the multimedia message of **MOSTAFA** were encrypted, as suggested in the Office Action, the relays of **MOSTAFA** would not be able to determine the address of the intended recipient of the encrypted multimedia message. Consequently, the relays of **MOSTAFA** would not be able to address the intended recipient, thus preventing operation of the device taught in Mostafa. Thus, modifying the teachings of **MOSTAFA** to encrypt the multimedia message in accordance with the teachings of **CHANG** renders the device of **MOSTAFA** unsatisfactory for its intended purpose and completely inoperable. Thus, under M.P.E.P. § 2143.01(V), Appellants' claims are not obvious over the **MOSTAFA** reference, alone or in any permissible combination with the **CHANG** reference. Put quite simply, modifying the teachings of **MOSTAFA** to encrypt the multimedia messages would destroy the operability of the **MOSTAFA** reference. Further, nothing in the **MOSTAFA** or **CHANG** references would teach or suggest excluding the addressing information from the encapsulated multimedia message specifically

taught in **MOSTAFA**. Rather, the exclusion of this information from the multimedia message of **MOSTAFA** would be directly contrary to the teachings of the **MOSTAFA** reference and would clearly only be suggested as the result of impermissible hindsight reconstruction of Appellants' claimed invention.

For the foregoing reasons, among others, the **MOSTAFA** and **CHANG** references are not combinable to render obvious Appellants' claimed invention.

- C. **The combination of MOSTAFA and KELLERMAN suggested in the Office Action does not teach, but rather, teaches away from, Appellants' invention of claims 22 and 46, which require, among other things, the transmission from the data provisioning component to the switching component of information relating to a usability check.**

Appellants' claims additionally require, among other limitations of Appellants' claims: 1) that the switching component transmits a "request" for checking the usability of the user data object "together with" the "determined" profiles of the capabilities of the first telecommunications terminal to the data provisioning component; and 2) that the data provisioning component transmits information relating to the usability check to the switching component. Pages 4 – 5 of the Office Action acknowledge that **MOSTAFA** does not disclose transmitting of a request, by the switching component, together with the "determined" profiles of the capabilities of the first telecommunications terminal to the data provisioning component. Instead, the Office Action points to the **KELLERMAN** reference as allegedly disclosing this feature, in combination with **MOSTAFA**. Appellants respectfully disagree.

More particularly, the **KELLERMAN** reference discloses sending a profile to a server, which, in turn, reformats (i.e., **transcodes**) **the content of a media channel based on a profile**. In **KELLERMAN**, the server then **sends the transcoded content** to the end-user device which consumes (uses) the content. See, for example, col. 6 of **KELLERMAN**, lines 57-63. However, if the server of **KELLERMAN** **always reformats the media into a format usable by the end-user device**, per col. 6 of **KELLERMAN**, there is no need for a further usability check to be provided, or for informing the switching component about the results of a usability check, as required by Appellants' claims. Rather, all media would be usable by the end-user, since **KELLERMAN** teaches reformatting the media so as to be usable by the end-user prior to sending it.

Thus, a combination of **MOSTAFA** and **KELLERMAN**, as suggested in the Office Action, would teach a person of ordinary skill in this art away from Appellants' claimed invention which requires: 1) that the switching component transmits a "request" for checking the usability of the user data object "together with" the "determined" profiles of the capabilities of the first telecommunications terminal to the data provisioning component; and 2) that the data provisioning component transmits information relating to the usability check to the switching component. Such a usability check has been obviated by the reformatting performed in the **KELLERMAN** reference. As such, Appellants' claimed invention is not rendered obvious by the combination of **MOSTAFA** and **KELLERMAN**.

D. Appellants' dependent claims 23, 24 and 28 even further distinguish the claimed invention over the cited art.

With regard to claims 23, 24, 28, Appellants note that encryption of the multimedia message of **MOSTAFA** is incompatible with the operability of the system of **MOSTAFA**, as discussed above. Therefore, **MOSTAFA**, alone or in any combination, cannot be said to teach or suggest an encrypted user data object.

E. Appellants' dependent claim 27 is, also, even further distinguished over the cited art.

With regard to claim 27, the Office Action points to page 20 of **MOSTAFA**, line 11 as allegedly disclosing an address containing a URL. However, the URL mentioned in the cited portion of **MOSTAFA**, belongs to the notification (see page 20, line 5-11) formed by the MMS relay (see page 19, lines 16-21). The claim wording, however, requires that the URL be part of the address contained in the reference that is received by the switching component.

F. Appellants' dependent claim 29 even further distinguishes over the cited art.

Further, with regard to claim 29, **MOSTAFA** fails to teach or suggest, among other things, that the information to the switching component contains a pointer to a data provisioning component from which a suitable user data object can be requested. Actually, **MOSTAFA** teaches that the translation of the component is carried out by that network entity that also carries out the other method steps. See, for example, pg. 6 of **MOSTAFA**, lines 15-25 and pg. 7 of **MOSTAFA**, lines 21-28. According to page 25 of **MOSTAFA**, lines 30-31, this network entity is the recipient MMS relay.

However, it would be senseless to provide a pointer to the recipient MMS relay pointing to itself.

II. Whether or not claim 43 is obvious over international publication WO 02/43414 to Mostafa in view of US Patent No. 6,963,972 to Chang, US Patent No. 7,296,295 to Kellerman as applied to claim 22 above, and further in view of USP application publication 2002/0077986 to Kobata et al., under 35 U.S.C. § 103(a).

On page 10 of the final Office Action, Appellants' dependent claim 43 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over **MOSTAFA, CHANG** and **KELLERMAN**, as applied to claim 22, and further in view of U. S. Patent Application Publication No. 2002/0077986 to Kobata et al ("**KOBATA**"). Appellants respectfully traverse the rejection of claim 43 made in the final Office Action.

More particularly, Appellants' claim 43 depends directly from independent claim 22. As discussed in Section 1, above, Appellants' independent claim 22 is believed to be patentable over the **MOSTAFA, CHANG** and **KELLERMAN** references. The **KOBATA** reference, however, does not cure the deficiencies of the **MOSTAFA, CHANG** and **KELLERMAN** references, discussed in Section 1, above. As such, Appellants' believe that claim 43 is additionally patentable over the cited art for the same reasons as claim 22, among other reasons.

III. Conclusion.

For the foregoing reasons, among others, Appellants' claims are believed to be patentable over the references cited in the final Office Action.

The honorable Board is therefore respectfully urged to reverse the final rejection of the Primary Examiner.

If an extension of time is required for this submission, petition for extension is herewith made. Any fees due should be charged to Deposit Account No. 12-1099 of Lerner Greenberg Sterner LLP.

Respectfully submitted,

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Claims Appendix:

22. A method of determining the usability of encrypted user data objects by a first telecommunications terminal, which comprises the following steps:

receiving, by a switching component of a telecommunications network, -an encrypted user data object to be transmitted to the first telecommunications terminal and a reference for checking a usability of the encrypted user data object by the first telecommunications terminal, the switching component not having access to a content of the encrypted user data object due to the encryption;

the switching component determining a profile relating to capabilities of the first telecommunications terminal to process a user data object;

transmitting, by the switching component, a request together with the determined profile of the first telecommunications terminal to a data provisioning component in accordance with an address contained in the reference for checking the usability of the encrypted user data object by the first telecommunications terminal;

transmitting, from the data provisioning component to the switching component, information relating to a result of the check on the usability of the encrypted user data object to be transmitted for the first telecommunications terminal; and

the switching component processing the encrypted user data object in accordance with the information relating to the check, and notifying the first telecommunications terminal thereof.

23. The method according to claim 22, wherein the encrypted user data object and the reference are provided in a container object.

24. The method according to claim 22, which comprises transmitting the encrypted user data object from a second telecommunications terminal to the switching component, for forwarding to the first telecommunications terminal.

25. The method according to claim 22, wherein the step of determining the profile relating to the capabilities of the first telecommunications terminal comprises sending a query to a database of the telecommunications network wherein the terminal device characteristics are stored.

26. The method according to claim 22, which comprises determining the profile relating to the capabilities of the first telecommunications terminal by sending a query to the first telecommunications terminal.

27. The method according to claim 22, wherein the address contained in the reference includes a URL.

28. The method according to claim 22, wherein the encrypted user data object to be transmitted is also transmitted to the data provisioning component in addition in the request of the switching component to the data provisioning component.

29. The method according to claim 22, wherein, if the result of the check by the data provisioning component is negative, the information to the switching component contains a pointer to the data provisioning component from which the switching component can request a different usable user data object in accordance with the profile of the first telecommunications terminals.

30. The method according to claim 22, wherein, if the result of the check by the data provisioning component is negative, the information to the switching component contains a different usable user data object.

31. The method according to claim 22, wherein the first telecommunications terminal, in response to the notification of the switching component concerning the provision of a usable encrypted user data object, transmits a request for the usable encrypted user data object to be sent to the switching component, and the switching component thereupon sends the usable encrypted user data object to the first telecommunications terminal.

32. The method according to claim 24, which comprises transmitting data to and from at least one of the first and second telecommunications terminals via an air interface.

33. The method according to claim 32, wherein at least one of the first and second telecommunications terminal comprises a radio module.

34. The method according to claim 33, wherein at least one of the first and second telecommunications terminal is a mobile telephone, a cordless telephone, or a portable computer.

35. The method according to claim 32, which comprises transmitting messages to and from at least one of the first and second telecommunications terminal using WAP protocols or Hypertext Transfer Protocol.

36. The method according to claim 22, wherein the first telecommunications terminal is part of a first telecommunications network.

37. The method according to claim 36, wherein the first telecommunications network is a mobile radio network.

38. The method according to claim 37, wherein the first telecommunications network operates in GSM or UMTS standard.

39. The method according to claim 36, wherein the switching component forms a part of a second telecommunications network that is connected to the first telecommunications network.

40. The method according to claim 39, wherein the second telecommunications network is a telecommunications network based on Internet protocols.

41. The method according to claim 40, wherein the second telecommunications network is a telecommunications network based on Hypertext Transfer Protocol.

42. The method according to claim 40, wherein the first and second telecommunications networks are connected to one another by way of a WAP gateway.

43. The method according to claim 22, which comprises, following receipt of the encrypted user data object, transmitting a rights object containing a key and usage rights for the received encrypted user data object.

44. The method according to claim 22, wherein the data provisioning component is a server of a content provider.

45. The method according to claim 22, wherein the user data object contains text information, audio information, video information, an executable program, a software module, or a combination thereof.

46. A telecommunications system for determining the usability of encrypted user data objects by a first telecommunications terminal, comprising:

a switching component;

a data provisioning component; and

at least one first telecommunications terminal;

said switching component configured to provide an encrypted user data object to be transmitted to the at least one first telecommunications terminal and a reference for checking a usability of the encrypted user data object by the at least one first telecommunications terminal, the switching component not having access to a content of the encrypted user data object due to the encryption;

said switching component additionally configured to determine a profile relating to capabilities of the at least one first telecommunications terminal to process a user data object;

said switching component configured to transmit a request, together with the determined profile of the first telecommunications terminal, to said data provisioning component in accordance with an address contained in the reference for checking whether the encrypted user data object to be transmitted is usable for processing by the at least one first telecommunications terminal;

said data provisioning component configured to transmit to the switching component, information relating to a result of the check on the usability of the encrypted user data object to be transmitted for the at least one first telecommunications terminal; and

said switching component configured to process the encrypted user data object in accordance with the information relating to the result of the check, and to notify the at least one first telecommunications terminal thereof.

Evidence Appendix:

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence has been entered by the Examiner and relied upon by appellant in the appeal.

Related Proceedings Appendix:

No prior or pending appeals, interferences or judicial proceedings are in existence which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal. Accordingly, no copies of decisions rendered by a court or the Board are available.